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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/976,630      | 10/11/2001  | Robert E. Haines     | 10007585-1          | 1660             |

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

| EXAMINER |
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AILES, BENJAMIN A

| ART UNIT | PAPER NUMBER |
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2142

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/976,630 | <b>Applicant(s)</b><br>HAINES, ROBERT E. |  |
|                              | <b>Examiner</b><br>Benjamin A. Ailes | <b>Art Unit</b><br>2142                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08252005</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is in response to Amendment "B" filed 25 August 2005.
2. Claims 1-36 remain pending. Claims 37-39 have been withdrawn from consideration (see Election/Restrictions section below for explanation).

### ***Election/Restrictions***

3. Newly submitted claims 37-39 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
  - a. Group I: Claims 1-36 are directed towards downloading configuration data and configuring a hard copy output engine using the downloaded configuration data, classified in class 709, subclass 220 (network computer configuring).
  - b. Group II: Claims 37-39 are directed towards discovering a plurality of hard copy output engines that exist in a computer network, classified in class 709, subclass 224 (computer network monitoring).

The inventions are distinct, each from the other because of the following reasons:

4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as the ability to discover hard copy output engines coupled to the network. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, Group I, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 37-39 (Group II) have

been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5-9, 12-17, 19-22, and 25-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayward et al. (U.S. 6,629,134), hereinafter referred to as Hayward et al.

7. Regarding claims 1, 8, and 21, Hayward et al. disclose a method of configuring a hard copy output engine comprising:

- Downloading data including a configuration plug-in and configuration data each including user-specified information (col. 4, lines 12-19 and col. 7, lines 48-60); and
- Configuring the hard copy output engine using the downloaded data (col. 7, lines 48-60).

8. Regarding claim 15, Hayward et al. disclose a computer implemented control system for a hard copy output engine, the system comprising:

- Memory configured to store a software module (col. 4, lines 15-19 and col. 6, lines 47-53); and
- Processing circuitry configured to employ the software module to:
  - Download data including a configuration plug-in and configuration data each including user-specified information (col. 4, lines 12-19 and col. 7, lines 48-60); and
  - Configure a hard copy output engine using the downloaded data (col. 7, lines 48-60).

9. Regarding claims 2, 9, 16, and 22, in accordance with claims 1, 8, 15, and 21, respectively, Hayward et al. disclose the method wherein the configuration plug-in and configuration data include data prepared by:

- Determining a make and model for the hard copy output engine (see Abstract and col. 3, line 65 – col. 4, line 2); and
- Determining user thresholds for consumables associated with the hard copy output engine (col. 8, lines 38-44).

10. Regarding claim 3, in accordance with claim 1, Hayward et al. disclose the method wherein downloading includes:

- Sending an electronic message via the Internet to a website for a vendor associated with the hard copy output engine (col. 4, lines 5-11); and
- Receiving an electronic message via the Internet in response to sending (col. 4, lines 13-18).

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11. Regarding claims 5, 12, 17, and 25, in accordance with claims 1, 8, 15, and 21, respectively, Hayward et al. disclose the method wherein configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (col. 2, lines 33-35 and col. 8, lines 38-44).

12. Regarding claims 6, 13, 19, and 26, in accordance with claims 1, 8, 15, and 21, respectively, Hayward et al. disclose the method wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (col. 3, lines 44-48).

13. Regarding claims 7, 14, 20, and 27, in accordance with claims 1, 8, 15, and 21, respectively, Hayward et al. disclose the method wherein the configuration plug-in and configuration data include data prepared by:

- Determining a make and model for the hard copy output engine (see Abstract and col. 3, line 65 – col. 4, line 2);
- Determining a serial number for the hard copy output engine (see Abstract and col. 3, line 65 – col. 4, line 2 and col. 4, lines 56-60); and
- Determining user thresholds for consumables associated with the hard copy output engine (col. 8, lines 38-44).

14. Regarding claim 28, Hayward discloses the method wherein the downloading comprising downloading a value, and the configuring comprises setting a threshold for a consumable associated with the hard copy output engine using the value (col. 4, lines 12-19 and col. 8, lines 38-44).

15. Regarding claims 29 and 34, Hayward discloses the method wherein the downloading comprising downloading a threshold for replenishment of a consumable associated with the hard copy output engine (col. 4, lines 12-19 and col. 8, lines 38-44).
16. Regarding claim 30, Hayward discloses the method wherein the configuring comprises setting the threshold of the hard copy output engine (col. 4, lines 12-19 and col. 8, lines 38-44).
17. Regarding claim 31, Hayward discloses the method further comprising:  
providing the user-specified information from a user col. 4, lines 12-19 and col. 7, lines 48-60; and  
generating at least one of the configuration plug-in and configuration data using the user-specified information before the downloading (col. 3, lines 54-64).
18. Regarding claim 32 and 35, Hayward discloses the method wherein the configuring comprises altering the hard copy output engine (col. 4, lines 12-19).
19. Regarding claims 33 and 36, Hayward discloses the method wherein the configuring comprises altering an operation of the hard copy output engine with respect to formation of hard images upon paper (col. 4, lines 12-19, it is deemed inherent that hard copy output engines can and most commonly print or place hard images on paper.).

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 4, 10, 11, 18, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward et al. in view of Uchida et al. (U.S. 6,317,570), hereinafter referred to as Uchida et al.

Regarding claims 4, 10, 11, 18, 23, and 24, Hayward et al. disclosed the method of sending and receiving electronic message transmissions (col. 4, lines 5-11, 13-18) via the Internet and Internet access provided by Internet service providers, but are silent on the use of a firewall. However in related prior art, Uchida et al. disclose a method for a user and a service center for the peripherals to establish communication via the Internet and have it secured by use of a firewall (see Fig. 1, Fig. 2, col. 3, lines 3-35). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to utilize the use of a firewall as disclosed in the method of communication utilized by Uchida et al. in order to achieve the desired level of security and protection a firewall offers (Uchida et al., col. 3, lines 3-4 and 30-32). It is for this that one of ordinary skill in the art would have been motivated to modify and improve the communication method disclosed by Hayward et al. to represent the more secure communication via the Internet method disclosed by Uchida et al.

### ***Response to Arguments***

22. Applicant's arguments filed 25 August 2005 have been fully considered but they are not persuasive.

23. (A) Referring to claim 1, the Applicant argues that Hayward does not teach "downloading a configuration plug-in."



24. As to point (A), the Examiner respectfully disagrees. As instructed, an Examiner is to take the broadest reasonable interpretation of a claim in light of the specification provided, and due to the fact that the use of a configuration plug-in was not clearly defined in detail in the instant application's specification, the Examiner has been required to define the term using the acceptable definition as is known in the art. A plug-in is merely an add-on to a larger application that assists in completing a smaller task or subroutine. In this case, a "configuration plug-in" would be defined as any type of program or subroutine that assists in the steps of completing configuration of a hard copy output engine. Hayward utilizes the use of a HTML formatted page in conjunction with installation software in order to complete the configuration of a device that is to be configured. The HTML formatted page in conjunction with the web browser which is accessed over a network connection being the applicant's "configuration plug-in". It is deemed well known in the art that web browsers use software plug-ins to complete tasks and subroutines (i.e. installation wizards, media players etc.). Hayward demonstrates this in column 3, line 54 – column 4, line 11. A user provides information to the software program (or plug-in) that is downloaded over a network connection onto a user's machine and appropriate information is retrieved. Due to this rationale, claim 1 stands rejected in view of Hayward.

25. (B) Applicant argues that Hayward does not disclose or suggest "the configuration plug-in or configuration data each including user-specified information."

26. As to point (B), the Examiner respectfully disagrees. As instructed, an Examiner is to take the broadest reasonable interpretation of a claim in light of the specification

provided, and due to the fact that the use of user-specified information was not clearly defined in detail in the instant application's specification, the Examiner has been required to define the term using the acceptable definition as is known in the art. The Examiner interprets "user-specified information" as any type of data a user provides which is imperative for the configuration data to be retrieved appropriately. Hayward clearly discloses a user providing information in column 3, lines 54-64 in order to correctly receive appropriate configuration data which is in turn used to configure the network device (i.e. hard copy output engine).

27. (C) Applicant argues that Hayward does not teach the performance of any configuration operations.

28. As to point (C), the Examiner respectfully disagrees. Again, as mentioned before, the Examiner is instructed to take the broadest reasonable interpretation of a claim in light of the specification provided. The Examiner directs the applicant's attention to column 4, lines 13-19 and 42-45 wherein the vendor web site provides all data needed by the user in order for the networked device (i.e. hard copy output engine) to be configured properly. Hayward provides an environment wherein a user is supplied with the latest configuration setup in order to be up to date with the latest release of configuration information/data.

29. (D) Applicant argues that Hayward does not include any "user-specified information".

30. As to point (D), the Examiner respectfully disagrees. As mentioned above in point (B), an Examiner is to take the broadest reasonable interpretation of a claim in

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light of the specification provided, and due to the fact that the use of user-specified information was not clearly defined in detail in the instant application's specification, the Examiner has been required to define the term using the acceptable definition as is known in the art. The Examiner interprets "user-specified information" as any type of data a user provides which is imperative for the configuration data to be retrieved appropriately. Hayward clearly discloses a user providing information in column 3, lines 54-64 in order to correctly receive appropriate configuration data which is in turn used to configure the network device (i.e. hard copy output engine). If a user does not specify any information at all, the user would not be expected to receive ANY of the correct configuration data they expect to receive from the server.

31. (E) Applicant argues that Hayward does not teach the claim limitation "configuring the hard copy output engine using the downloaded data."

32. As to point (E), the Examiner respectfully disagrees. Again, as mentioned before, the Examiner is instructed to take the broadest reasonable interpretation of a claim in light of the specification provided. As mentioned in point (C), the Examiner directs the applicant's attention to column 4, lines 13-19 and 42-45 wherein the vendor web site provides all data needed by the user in order for the networked device (i.e. hard copy output engine) to be configured properly. Hayward provides an environment wherein a user is supplied with the latest configuration setup in order to be up to date with the latest release of configuration information/data.

33. (F) Applicant argues that Hayward does not teach "configuration plug-in and configuration data include data prepared by determining user thresholds for consumables."

34. As to point (F), the Examiner respectfully disagrees. Hayward clearly discloses the use of the configuration and plug-in and configuration data as mentioned above in points (A) and (B). Hayward uses configuration data retrieved from the web server in order to be supplied with the latest configuration setup in order to be up to date with the latest release of configuration information/data. It is deemed by the Examiner inherent that peripheral condition information would be included in this type of information in order for the hard copy output engine to indicate when consumables are running low. This being mentioned by Hayward in column 4, lines 12-19 and column 8, lines 38-44. Hayward uses peripheral conditions to determine when consumables are low (i.e. paper low, ink level low).

35. (G) Applicant argues that Hayward does not teach all of the claim limitations of claim 8.

36. As to point (G), Applicant's attention is directed to points (A)-(E) above.

37. (H) Applicant argues that Hayward does not teach all of the claim limitations of claim 15.

38. As to point (H), Applicant's attention is directed to points (A)-(E) above.

39. (I) Applicant argues that Hayward does not teach all of the claim limitations of claim 15.

40. As to point (I), Applicant's attention is directed to points (A)-(E) above.

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41. In regards to newly added claims 28-39, applicant's attention is directed to the rejections applied above.

***Conclusion***

42. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action (in regards to newly added claims). Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes whose telephone number is (571)272-3899. The examiner can normally be reached on M-F 6:30-4, IFP Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Andrew Caldwell". The signature is fluid and cursive, with the first name "Andrew" and last name "Caldwell" clearly distinguishable.

**ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER**